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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,622	03/22/2001	Mark E. Cannon	CANN-0208	3984
7590 05/21/2004				
Schmeiser, Olsen & Watts LLP 18 East University Drive, #101 Mesa, AZ 85201				
			EXAMINER FLEURANTIN, JEAN B	
			ART UNIT 2172	PAPER NUMBER

DATE MAILED: 05/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/814,622

Applicant(s)

CANNON, MARK E.

Examiner

Jean B Fleurantin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2004 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12,14-22 and 88-118 is/are pending in the application.
- 4a) Of the above claim(s) A is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 12,14-22 and 88-118 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This is response to the RCE filed on 5 March 2004, in which claims 12, 14-22 and 88-118 remain pending for examination.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 12, 14 and 88-95 are drawn to a computer system for optimizing an advertising schedule for an advertisement message, the computer system comprising: a CPU; a memory coupled to the CPU; a database residing in the memory, the database containing a plurality of audience member data, the plurality of audience member data indicating exposure of each corresponding audience member to at least one of media and advertisements for the message; a database mining engine residing in the memory, classified in class 707, subclass 1.

- II. Claims 15-22, 96-100 and 118 are drawn to a program product comprising: an advertising plan optimization mechanism for generating a plan for providing an advertisement message to a preselected group of potential message recipients, classified in class 705, subclass 14.

- III. Claims 101-117, are drawn to a program product for calculating a score for an advertisement message to be provided to a preselected group of potential message recipients, classified in class 705, subclass 10.

The inventions are distinct, each from the other because of the following reasons:

The inventions in Groups I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instance case, invention Group I has separate utility such as a CPU; a memory coupled to the CPU; a database residing in the memory, the database containing a plurality of audience member data, the plurality of audience member data indicating exposure of each corresponding audience member to at least one of media and advertisements for the message; a database mining engine residing in the memory. Invention Group II has separate utility such as an advertising plan optimization mechanism for generating a plan for providing an advertisement message to a preselected group of potential message recipients. Group III has separate utility such as a program product for calculating a score for an advertisement message to be provided to a preselected group of potential message recipients.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR

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1.48(b) and by the fee required under 37 CFR 1.17(i).

During a telephone conversation with Mr. Kenneth C. Booth (Reg. No. 42,342) on April 2004 a provisional election was made with traverse to prosecute the invention of a program product comprising: an advertising plan optimization mechanism for generating a plan for providing an advertisement message to a preselected group of potential message recipient, claims 15-22 and 96-117. However, upon further analysis the Examiner notes that a further Group exists namely Group III consists of claims 101-117. Thus applicant is invited to reevaluated his/her election based on the newly structured grouping of the pending claims. Applicant in replying to this Office Action must make affirmation of an election.

Applicants are advised that the to this requirement to be complete must include and election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one more of the currently named inventors in no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

[remainder of page intentionally left blank]

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### CONTACT INFORMATION

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B Fleurantin whose telephone number is 703-308-6718. The examiner can normally be reached on 7:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John B Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean Bolte Fleurantin

May 2, 2004



SHAHID ALAM  
PRIMARY EXAMINER